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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,258	07/18/2003	Allison Fay Searcy	DC-05200	4683
33438	7590	08/28/2008	EXAMINER	
HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720				JARRETT, SCOTT L
ART UNIT		PAPER NUMBER		
3623				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/623,258	SEARCY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SCOTT L. JARRETT	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 June 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-8,18,20-26,36 and 38-44 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3-8,18,20-26,36 and 38-44 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This Non-Final Office action is in response to applicant's amendments filed June 19, 2008. Applicant's amendments amended claims 1, 3-8, 18, 20-26, 36 and 38-44 and canceled claims 2, 9-17, 19, 27-35 and 37. Currently claims 1, 3-8, 18, 20-26, 36 and 38-44 are pending.

This action has been made Non-Final in order to raise a new grounds of rejection under 35 U.S.C. 101.

***Response to Amendment***

2. The Double Patenting rejection under 35 U.S.C. 101 of claims 1-8, 18-26 and 26-44 is withdrawn in response to Applicant's Terminal Disclaimer filed June 19, 2008.

The Objection to the Title in the previous office action is withdrawn in response to applicant's amendment to the Title.

The Objection to claims 1-8, 18-26 and 36-44 is withdrawn in response to Applicant's amendments to claims 1, 3-8, 18, 20-26, 36 and 38-44 and cancellation of claims 2, 9-17, 19, 27-35 and 37.

***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 3-8, 18, 20-26, 36, and 38-44 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1 and 3-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1 and 3-8 fail to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical

limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-8, 18, 20-26, 36 and 33-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corbett, Delivery Windows – A New View On Improving Manufacturing Flexibility and On-Time Delivery Performance (1992) in view of Chowdhary et al., U.S. Patent no. 7,212,991.

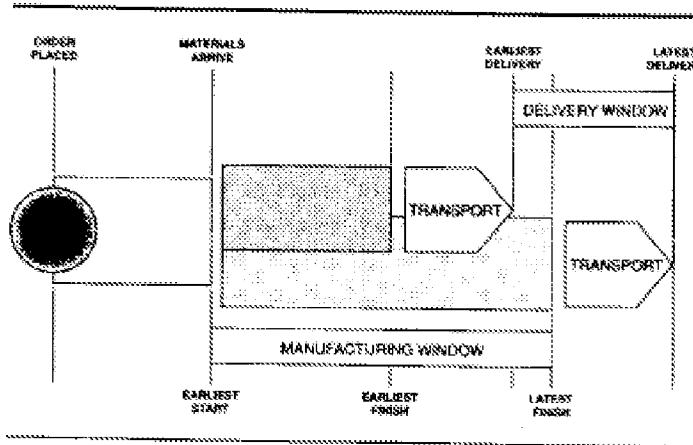
Regarding Claims 1, 18 and 36 Corbett teach a system and method for scheduling manufacture (production, assembly, etc.) of an item comprising:

- obtaining a customer order comprising an item ordered and a desired shipping schedule corresponding to a shipping method (Column 1, Last Paragraph, Page 75; Column 2, Paragraph 1, Page 75);

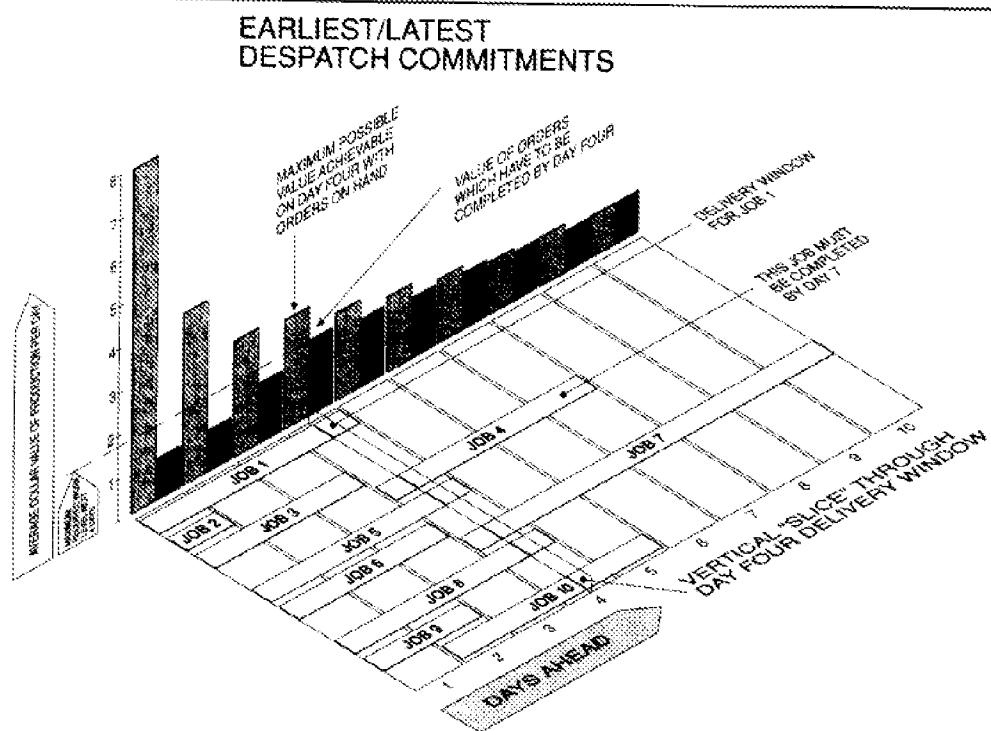
- planning a time for manufacture (production, assembly, etc.) the item so that the item's manufacture completes during a desired shipping (delivery) window (Column 1, Page 75; Column 2, Paragraph 2, Page 75; Figures 2-4; Page 76; Column 1, Page 77);

- determining the desired shipping window so as to allow the item to be shipped/delivered on time (Column 1, Page 75; Column 2, Paragraph 2, Page 75; Figures 2-4; Page 76; Column 1, Page 77);

- scheduling manufacturing of the item based on the determining (Column 1, Page 75; Column 2, Paragraph 2, Page 75; Figures 2-4; Page 76; Column 1, Page 77).



**FIGURE 2: The delivery window concept**



**FIGURE 4: Earliest/latest despatch commitments**

While expedited shipping (priority, overnight, rush, etc.) is an old and very common business practice wherein business' frequently use expedited shipping to ensure on-time delivery performance or customers desiring to receive their items as soon as possible Corbett does not expressly teach that the customer order desired shipping schedule corresponds to an expedited shipping method or that the shipping window is determined so as to allow the item to be shipped via a lower cost shipping method while arriving at a destination (any destination) as if shipped via the expedited shipping method as claimed.

Chowdhary et al. teach obtaining a customer order comprising an item ordered and a desired shipping schedule corresponding to an expedited shipping method (Column 4, Lines 1-6; Column 8, Lines 1-8) and determining a desired shipping window so as to allow the item to be shipped via a lower cost shipping method (e.g. ground) while arriving at a destination as if shipped via the expedited shipping method (Column 1, Lines 33-43; Column 10, Lines 35-50; Column 11, Lines 25-42; Column 13, Number 5, Lines 44-50; Column 16, Numbers 5, 8) in an analogous art of order management for the purpose of shipment optimizing (e.g. reducing the cost of shipping an item to the customer while meeting the customer's requirements including delivery date; Column 1, Lines 40-45; Column 13, Lines 25-42; Column 13, Lines 44-47) .

It would have been obvious to one skilled in the art at the time of the invention that the system and method for scheduling manufacturing of an item in a factory to meet a delivery window as taught by Corbett would have benefited from utilizing a lower cost shipping method to replace a requested expedited shipping method while still ensuring the item arrived at its destination on-time in view of the teachings of Chowdhary et al.; the resultant system/method enabling businesses to meet customer shipment/delivery windows at a reduced cost (Chowdhary et al.: Column 1, Lines 40-45; Column 13, Lines 25-42; Column 13, Lines 44-47).

Regarding Claims 3, 20 and 38 Corbett teaches a manufacturing scheduling system and method wherein the item is in an information handling system (Column 2, Paragraph 2, Page 77; Figures 2-4).

Regarding Claims 4, 21 and 39 Corbett teaches a manufacturing scheduling system and method further comprising a destination (a destination is inherent in customer order requiring shipment/delivery) for the shipment of the item (Page 75; Column 2, Paragraph 2, Page 77).

Regarding Claims 5, 22 and 40 while determining the size, weight, etc. of shipments (orders) is old and very well known Corbett does not expressly teach determining a size of the order as claimed.

Chowdhary et al.. teach determining a size (volume, weight, number of items for split orders) of the order (Column 10, Lines 25-28; Column 13, Lines 11-13) in an analogous art of order management for the purpose of determining which shipment method to utilize for the order as part of the 'optimal deal finder' wherein the 'size' of the order directly effects the cost of the shipping method.

It would have been obvious to one skilled in the art at the time of the invention that the system and method for scheduling the manufacture of an item by Corbett would have benefited from selecting an 'optimal' shipping method based on a plurality of criteria including but not limited to the size of the order in view of the teachings of Chowdhary et al.; the resultant system/method enabling businesses to select the lowest cost shipping method (Chowdhary et al.: Column 1, Lines 40-45; Column 13, Lines 25-42; Column 13, Lines 44-47).

Regarding Claims 6, 23, 24 and 41-42 Corbett teaches a manufacturing scheduling system and method further comprising determining a time of day that the planning is occurring (Column 1, Paragraph 3, Page 75; Column 2, Paragraph 2, Page 77).

Regarding Claims 7-8, 25-26 and 43-44 while air and ground shipping methods are old and very well known as it the practice of selecting the lowest cost shipping method to meet customer desired dates Corbett is silent as to the specific type (class,

category, mode, etc.) of shipment method used and does not expressly teach ground or air shipments as claimed.

Chowdary et al. teach a plurality of well known shipping methods including ground (lower cost) and air shipping (expedited; Column 8, Lines 5-8; Example 1, Column 13) in an analogous art of order management for the purpose of substituting a lower cost shipping method (ground) for a higher cost shipping method (air) while still maintaining the shipping/delivery window (Column 1, Lines 33-43; Column 10, Lines 35-50; Column 11, Lines 25-42; Column 13, Number 5, Lines 44-50; Column 16, Numbers 5, 8).

It would have been obvious to one skilled in the art at the time of the invention that the system and method for scheduling manufacturing of an item in a factory to meet a delivery window as taught by Corbett would have benefited from utilizing a lower cost shipping method like ground to substitute for a expedited shipping method while still ensuring the item arrived at its destination on-time in view of the teachings of Chowdhary et al.; the resultant system/method enabling businesses to meet customer shipment/delivery windows at a reduced cost (Chowdhary et al.: Column 1, Lines 40-45; Column 13, Lines 25-42; Column 13, Lines 44-47).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Nicholls et al., U.S. Patent No. 5,485,369, teach a system and method selecting a shipping method based on a plurality of shipping requirements (rules; e.g. required delivery date, transit time, cost).
- Smith et al., U.S. Patent No. 6,879,962, teach a system and method for selecting the lowest cost shipping method for an order that still meets the delivery window requirements/constraints.
- Wilson et al., U.S. Patent Publication No. 2002/0133387, teach a system and method for order management (from customer order to delivery/fulfillment) comprising selecting the minimal cost shipping method based on the customer selected shipping requirements (delivery dates, delivery date, etc.; Paragraphs 0037, 0056, 0061, 0069).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT L. JARRETT whose telephone number is (571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Van Doren Beth can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott L Jarrett/  
Primary Examiner, Art Unit 3623